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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,540	04/12/2000	William Allocca	23984-13942	5837
758 FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041				
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EXAMINER				
GARG, YOGESH C				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/547,540

**Applicant(s)**

ALLOCCA ET AL.

**Examiner**

Yogesh C. Garg

**Art Unit**

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 13-21, 23-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-21, 23-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/5/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3/5/2009 has been entered.

2. Claims 1-5, 7-10, 13-17, 19, 21, 24-26, 29, 31-33, 37-38, 40-41, 50, 53, 56, 59, 64-65, 67-68, and 129 are currently amended, and claim 22 is currently canceled. Claims 11-12, 28, 34, 39, 42-49, 66 and 69-128 were previously cancelled. Claims 1-10, 13-21, 23-27, 29-33, 35-38, 40-41, 50-65, 67-68 and 129 are currently pending.

Note: The applicant's remarks (see page 21) does not indicate that claim 22 is canceled but this claim is indicated as "canceled", see page 8. The examiner would go as per the claims submitted that is considering claim 22 as canceled.

### ***Response to Arguments***

3. Applicant's arguments filed 3/5/2009 have been fully considered but they are not persuasive. The applicant has argued that the use of Hartman reference (US patent

5,960,411) in rejecting claims under 35 USC 103 (a) is improper as per section 35 USC 103 (c). The examiner respectfully disagrees because Hartman reference is applicable under 35 USC 102 (a) as it was issued and published on September 28, 1999 earlier by 86 days than the priority date of 12/23/1999 of the instant application. Since Hartman reference is available under 35 USC 102 (a) it is proper to use it for rejecting claims under 35 USC 103 (a) and therefore rejection of claims 1-10, 13-21, 23-27, 29-33, 35-38, 40-41, 50-65, 67-68 and 129 can be maintained and argued in the Examiner's answer filed 9/14/2006 and Final rejection filed 7/8/2003.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 1-7, 9-10, 13, 15-21, 23-27, 29-33, 35, 37-38, 40-41, 50-65, 67-68, and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US Patent 5,960,411), hereinafter referred to as Hartman, in view of Yamada (US Patent 6,336,100 B1).

With regards to 1, 9, 10, 29, 31, 32, 33, 40, 41, 50, 56, 59, 64, 67, and 68, Hartman discloses a method, a system, a computer-readable medium, and a display device for assisting a user at a client system to place an order for an item to be received by a server system. The client system displays the information identifying the item, an element representing order fulfillment instructions for the identified item, receiving indication of the recipient with predefined

order fulfillment information including a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source/information, such that the payment information for procurement option will be used to pay for the identified item and such that delivery information for that procurement option will be used for the delivery of the identified item, and after selection by the user of a displayed indication, without further intervention, sending to server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected recipient using the shipping instructions and to be paid for by the payment source for the selected recipient, so that a single action orders and pays for the item (see at least FIGS 1A-1C, 2-7, 8A-8C, col.2, line 50-col.9, line 53. Note: In FIG.1C, reference number 108 discloses a " Ship to" , "Shipment Method: Standard Domestic Shipping", and a "Payment Method " information. In Hartman, , "Shipment Method: Standard Domestic Shipping" corresponds to the claimed shipping instructions along with the payment and delivery information to " John Doe at Home". The combination of ship to instructions, shipment method instructions and payment instructions correspond to an unique combination of delivery, shipping instructions different from delivery address and payment source/information).

Hartman also teaches to create new procurement option for ordering the identified item (see at least Fig.1B, "...Review or change your 1-click orders ", col.4, line 59-col.5, line 8). Hartman further teaches that a client identifier corresponds to multiple customers and these multiple customers can be identified by selecting a partially displayed purchaser-specific order information (see at least col.9, lines 54-63).

Hartman does not expressly teach providing for displaying at the client system a multiple/plurality of procurement/fulfillment options associated with a single user of the client system having information related to ordering the identified item. Yamada, in the same field of online shopping, teaches displaying at the client system a multiple/plurality of

procurement/fulfillment options associated with a single user of the client system having information related to ordering the identified item and allowing the user to select one of the multiple groups/procurement options (see at least FIGS. 2, 4, 5,6,9, col.1, lines 12-44, col.2, lines 57-65, col.3, lines 6-18, col.4, lines 15-30. Disclosing several predefined choices for delivery destination clearly corresponds to multiple pre-defined procurement options and satisfies the limitation recited in the independent claims 1, 10, and 29). In view of Yamada, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Hartman to provide at the client system a multiple/plurality of procurement/fulfillment options associated with a single user of the client system having information related to ordering the identified item as expressly taught in Yamada. Thus, when Yamada is combined with Hartman, for each different delivery address, would result in unique combinations of delivery address, shipping instructions different from delivery address, and payment source/information. Doing so would allow the user the novelty and the convenience to order items online for different destinations for him and/or gifts for individuals other than him (see at least col.1, lines 11-44, and col.3, lines 6-19). Note: different destinations mean customer's/user's home addresses or customer's designated addresses such as company addresses and other addresses for individuals other than him as explicitly disclosed in Yamada (see at least col.1, lines 11-44, and col.3, lines 6-19).

Note: The Examiner also invites the attention of the applicant to the details provided in the Examiner's answer mailed on 5/2/2006 and relevant comments of the Board decision mailed on 1/26/2009 concerning the above rejection of limitations recited in claims 1 and 29.

Hartman/Yamada further teaches all the limitations cited in claims 2-7, 13, 15-21, 23-27, 30, 35, 37, 38, 51-55, 57-58, 60-63, 65, and 129, (see Hartman, col.2, line 51-col.10, line 14, and Yamada, col.1, line 19-col.5, line 20).

4.2 Claims 8, is rejected under 35 U.S.C. 103(a) as being obvious over Hartman/Yamada in view of Official Notice.

With regards to claim 8, Hartman/Yamada teaches a method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order fulfillment information as disclosed in claim 1 and analyzed above. Hartman/Yamada does not disclose displaying an indication selecting a default groups out of the identified multiple groups. Official Notice is taken of both the well-known concept and benefits of providing a default program while working on the computers when several choices are available to the user to select one. If a user does not specify an alternative the program makes a choice automatically. In view of this well-known concept and its benefits it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include default program in Hartman/Yamada because if a user wants the purchased item to be delivered at his home then he can save time by not being bothered to select delivery information (see at least Yamada, Fig.9, col.3, lines 6-19) as the default program will automatically indicate the server in Hartman/Yamada to select home address if the user has not made any selection of the available multiple groups.

4.3. Claims 14, and 36, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman/Yamada in view of Holland et al. (US Patent 6,493,742), and hereinafter referred to as Holland.

With regards to claims 14, and 36, Hartman/Yamada teaches a method for a user at a client system to place an order for an item by indicating a single action, wherein the user have multiple procurement options of predefined order fulfillment information as disclosed in method claims 10, and 33, and analyzed above. Hartman/Yamada discloses indicating a selection of an option to deliver the item as a gift (see at least Yamada col3., lines 6-12). Hartman/Yamada does not disclose that the order request includes wrapping instructions for the item to be delivered. As per knowledge generally available wrapping gifts before delivering to the recipients is notoriously well known practice. In the same field of on online ordering gifts, Holland teaches including wrapping instructions while ordering a gift (see at least col.1, lines 26-46). In view of Holland and knowledge generally available it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include the wrapping

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kara (US Patent 6,233,568, see at least col.22, lines 40-38) discloses, in the same field of endeavor, presenting/displaying a plurality of options for shipping providers enabling a user to make an informed choice.
6. This is a Continuation of applicant's earlier Application No. 09/547540. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL**



even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yogesh C Garg/  
Primary Examiner, Art Unit 3625